

DOCKET NO.: 284648US0PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
Valerie DUPOUY

GROUP: 1772

SERIAL NO: 10/565,206

EXAMINER: Thomas, Alexander S.

FILED: January 20, 2006

FOR: MINERAL FIBRE-BASED SANDWICH STRUCTURE AND METHOD FOR
THE PRODUCTION THEREOF

RESTRICTION RESPONSE

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

Sir:

In response to the Restriction Requirement dated September 27, 2007, Applicants elect, with traverse, Group I, Claims 1-11, for examination.

REMARKS/ARGUMENTS

Applicants respectfully note that Claims 1-11 and 13-21 are active in this application. These claims are presented in the Listing of Claims in the Preliminary Amendment filed in this application January 20, 2007. The following response is based on those amended claims.

The claims have been divided into Groups as follows:

Group I: Claim(s) 1-11 and 17-21 drawn to a product.

Group II: Claim(s) 13-16, drawn to processes to make and use the product.

Applicants elect, with traverse, Group I, Claims 1-11 and 17-21, for examination.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness between the identified groups.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Office has asserted that Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because: "Evidence of lack of unity between the two groups is found in FR 2745597 wherein it is found to disclose the features of claim 1, namely a product with crimped mineral fibers and cover layers."

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

"The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any)."

Applicants respectfully submit that the Examiner has not provided any indication that the contents of the claims interpreted in light of the description was considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion.

Furthermore, 37 C.F.R. § 1.475(b) states in pertinent part:

"An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(3) A product and a process specially adapted for the manufacture of the said product, and a use of the said product; . . ."

Applicants respectfully submit that the Office has not considered the relationship of the inventions of Groups I-II with respect to 37 C.F.R. § 1.475(b)(3). Claims 1-11 and 17-21 are drawn to a product, Claims 13-14 are a process to manufacture the product and Claims 15 and 16 are drawn to a use of the product.

Moreover, Applicants respectfully refer to Annex B of the Administrative Instructions Under the PCT, paragraph (c), which states in part, "Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims." Claims 13-16 all depend directly or indirectly from Claim 1 in this application.

Therefore, Applicants respectfully submit that the burden necessary according to MPEP § 1893.03(d) to sustain the conclusion that the groups lack of unity of invention has not been met.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Jay E. Rowe Jr., Ph.D.

Registration No. 58,948

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 08/07)